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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,451	05/31/2001	Robert Lennie	PALM-3667	3020

7590 05/02/2005

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EXAMINER
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SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/872,451

Applicant(s)

LENNIE, ROBERT

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-33 are presented for examination.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-8, 11, 14-21, 24, and 27-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al. (6,421,707) (hereinafter Miller).

3. As per claims 1 and 27, Miller discloses a communication system and method comprising:

a notifications server (col 3, lines 33-35 and col 4, lines 4-15), coupled to the Internet (WWW access, col 4, line 12), and having a standard

electronic mail protocol (SMTP, col 4, line 11) for receiving standard formatted electronic mail messages (151, fig 1, col 6, lines 46-66);

wherein said notifications server (col 3, lines 33-35) is for storing a received electronic mail message (col 3, lines 3-5) and also is for automatically generating (col 5, lines 1-7, col 3, lines 30-35), therefrom, a subset of said received (subset is derived by the previously stored rules, col 5, lines 1-7) electronic mail message (col 3, lines 33-35); and

wherein said notifications server (col 3, lines 30-35), upon generation of said subset (subset is derived by the previously stored rules, col 5, lines 1-7 and col 3, lines 33-35), is for wirelessly transmitting (col 1, lines 5-10) said subset (col 3, lines 33-35) to an identified wireless electronic device (301, fig 3) associated with a user that is the recipient of said received electronic mail message (col 3, lines 43-51).

4. As per claim 14, the claim is rejected for the same reasons as claim 1, above. In addition Miller discloses a plurality of wireless electronic devices operable to communicate over a wireless communication network (col 3, lines 65-67 and col 4, lines 1-15).

5. As per claims 2, 15, and 28, Miller discloses said identified wireless electronic device is operable to display received subsets to a user (412, fig 4(d), col 4, lines 61-64).

6. As per claims 3, and 16, Miller discloses said identified wireless electronic device is operable to allow said user to select a particular received subset (col 4, lines 51-54) and wherein said notifications server is also for wirelessly downloading the remainder (col 5, lines 12-21) of an electronic mail message corresponding to said particular received subset in response to the selection thereof by said identified wireless electronic device (col 5, lines 22-26).

7. As per claims 4 and 17, Miller discloses said subset is a notification message comprising a sender's identification and a subject field (412, fig 4g) of said received electronic mail message (col 5, lines 22-25).

8. As per claims 5 and 18, Miller discloses said identified wireless electronic device is a handheld computer system having wirelessly enabled (412, fig 4(d), col 4, lines 61-64).

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9. As per claims 6, 19, and 31, Miller discloses wherein said notifications server comprises a user information database for providing a mapping between wireless electronic devices and their associated electronic mail addresses (col 3, lines 1-5).

10. As per claims 7, 20 and 32, Miller discloses a push packet (SMPP, col 4, line 6) is used by said notifications server to wirelessly (col 3, lines 65-67) transmit said subset to said identified wireless electronic device (col 3, lines 33-36).

11. As per claims 8 and 21, Miller discloses said subset is wirelessly transmitted by said notifications server using a wireless LAN communication network (col 10, lines 1-10).

12. As per claims 11, 24, and 33, Miller discloses said standard electronic mail protocol is substantially compliant with the SMTP protocol (Simple Mail Transport Protocol) (col 9, lines 33-36).

13. As per claim 29, Miller discloses the step of receiving said received electronic mail message over said Internet (col 4, lines 7-15).

14. As per claim 30, Miller discloses said identified wireless electronic device allowing said user to select a particular received notification message (col 5, lines 5-14); and

said notifications server wirelessly downloading the remainder of an electronic mail message corresponding to said particular received notification message in response to said user selecting said particular received notification message (col 5, lines 15-30).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 9, 10, 12, 13, 22, 23, 25, and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (6,421,707) (hereinafter Miller) in view of Mousseau et al. (US PUB 2002/0120696) (hereinafter Mousseau)

17. As per claims 9 and 22, Miller discloses said subset is wirelessly transmitted by said notifications server (col 3, lines 30-36 and col 4, lines 4-15). Miller does not explicitly disclose using a Bluetooth wireless communication network. However, Bluetooth wireless communication is well known in the art, for example, Mousseau discloses, using a Bluetooth wireless communication network (page 22, paragraph #0174). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Miller with Mousseau because Mousseau's use of Bluetooth communication module would provide Miller's system a standard like Bluetooth, the mobile device could receive a message with an attachments.

18. As per claims 10 and 23, Miller discloses said subset is wirelessly transmitted by said notifications server (col 3, lines 30-36 and col 4, lines 4-15). Miller fails to disclose using a Mobitex wireless communication network. However, Mousseau discloses using a Mobitex wireless communication network (page 21, paragraph #0164). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Miller with Mousseau because Mousseau's use of Mobitex mobile communication subsystem would provide Miller's system an open global first-generation standard for narrowband wireless packet switched



communications in the 900MHz (and lower) band for mobile terminals and fixed-to-point communications.

19. As per claims 12 and 25, Miller discloses said standard electronic mail protocol is substantially compliant with the SMTP protocol (col 3, lines 30-36 and col 4, lines 4-15). Miller does not explicitly disclose POP protocol. However, Mousseau discloses POP protocol (page 9, paragraph #0084). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Miller with Mousseau because Mousseau's use of POP protocol would provide Miller's system an e-mail system using industry standard mail protocols.

20. As per claims 13 and 26, Miller discloses said standard electronic mail protocol is substantially compliant with the SMTP protocol (col 4, lines 4-15). Miller does not explicitly disclose IMAP protocol. However, Mousseau discloses IMAP protocol (page 9, paragraph #0084). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the teaching of Miller with Mousseau because Mousseau's use of IMAP protocol would provide Miller's system an e-mail system using industry standard mail protocols.

***Response to Arguments***

21. Applicant's arguments filed 12/27/2004 have been fully considered but they are not persuasive, therefore rejections to claims 1-33 is maintained.

22. In the remarks applicants argued that:

A. Miller et al. does not anticipate or render obvious a communication system that includes a notifications server that generates a subset of a received electronic mail message and that wirelessly transmits "the subset to an identified wireless electronic device associated with a user that is the recipient of said received electronic mail message".

23. In response to applicants argument A, the examiner respectfully disagrees. Miller teaches a notifications server (320, fig 3, col 3, lines 33-35 and col 4, lines 4-15), that generates a subset of said received (notification of Radhika's e-mail, col 5, lines 2-5, fig 4(f), 412) electronic mail message (col 3, lines 33-35, notification of the message); subset (subset is derived by the previously stored rules, col 5, lines 1-7 and col 3, lines 33-35), is for wirelessly transmitting (col 1, lines 5-10) said subset (col 3, lines 33-35) to an identified wireless electronic device (301, fig 4(e) col 5, line 5, Thomas

handset ) associated with a user that is the recipient of said received electronic mail message (col 3, lines 43-51 and fig 4(e) col 5, line 2-5, Thomas handset).

### ***Conclusion***

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

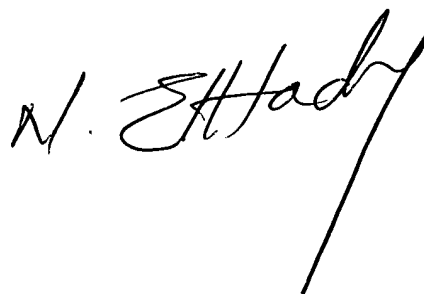
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAS

A handwritten signature in black ink, appearing to read "N. E. Hadley", with a long diagonal stroke extending downwards and to the right.